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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/976,679

10/12/2001

Scott A. McGill

PERCUS.141A

1188

20995

7590

06/28/2004

KNOBBE MARTENS OLSON & BEAR LLP

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EXAMINER

BAXTER, JESSICA R

ART UNIT

PAPER NUMBER

3731

DATE MAILED: 06/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/976,679	MCGILL ET AL.	
	Examiner	Art Unit	
	Jessica R Baxter	3731	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 April 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 3,5,6,10-16,20,22,23,25,26 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,2,4,7-9,27 and 28 is/are allowed.
- 6) ☒ Claim(s) 17-19,21,24 and 29-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 17-19 and 21, 24 and 29-31 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,544,231 to Palmer et al.

Regarding claim 17, Palmer discloses a medical device, comprising: an elongate tubular body having a proximal end and a distal end and a lumen extending therethrough (tubular member 102); an inner wire within the lumen of the elongate tubular body having a proximal end extending proximal to the proximal end of the elongate tubular body and a distal end (needle 16 shaft 16), the inner wire being moveable relative to the elongate tubular body (FIGS. 3-5); an expandable member connected to the distal end of the elongate tubular body (basket 116); and a coil extending over the inner wire at a proximal end thereof (coil 14), the coil being attached to the proximal end of the elongate tubular body (Column 7 line 58-Column 8 line 25). Palmer discloses a proximal hypotube (tube 12) connected to a proximal end of the coil, wherein the inner wire extends through the proximal hypotube.

Regarding claim 18, Palmer discloses that the expandable member is an occlusive device (basket 116) having a proximal end connected to the tubular body and a distal end connected to the inner wire (FIG. 3), wherein relative movement of the inner wire with

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respect to the tubular body causes the occlusive device to move from a nonexpanded configuration to an expanded configuration (FIGS. 3-5).

Regarding claim 19, Palmer discloses that when the occlusive device is in its expanded configuration, a gap is defined between the tubular body and the proximal hypotube (FIG. 4).

Regarding claim 21, Palmer discloses a coil (coil 14) between the proximal hypotube and the tubular body.

Regarding claims 29 -31, Palmer discloses a medical device comprising an elongate tubular body (102), an inner wire (16); an expandable member connected to the distal end of the elongate tubular body and to the distal end portion of the inner wire (116); and a coil having a proximal and distal ends (14), the coil extending along the proximal end portion of the inner wire, the distal end of the coil being configured for abutting against the proximal end of the elongate tubular body (FIG. 5); wherein the proximal end of the coil is attached to the inner wire such that the coil limits distal advancement of the inner wire with respect to the tubular body ; further comprising a proximal hypotube providing a gripping mechanism (10).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Palmer et al. '231 in view of U.S. Patent No. 4,878,898 to Griffin et al.

Palmer discloses the claimed invention except for the expandable member being a balloon. Palmer teaches that his device may be used to insert a device to desired penetration depth or reference depth (Column 1 lines 28-40). Griffin teaches that a balloon catheter may be provided with a marking to indicate the penetration depth of the instrument (Column 4 line 55-Column 5 line 7). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the marker device (10) of Palmer with the balloon of Griffin since it is known in the art to provide balloon catheters with depth markers.

### ***Response to Arguments***

5. Applicant's arguments filed April 1, 2004 have been fully considered but they are not persuasive.
6. Applicant argues that the proximal hypotube of Palmer et al. '231 is not attached to the proximal end of the inner wire. In FIG. 5B of Palmer, a configuration is shown where the hypotube (12) is attached to the inner wire (112). Therefore, the rejection over Palmer et al. '231 is proper.

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the

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THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica R Baxter whose telephone number is 703-305-4069. The examiner can normally be reached on M-F 8:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, McDermott or Shaver can be reached on 703-308-0858. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jessica R Baxter  
Examiner  
Art Unit 3731

jrb

  
DAVID O. REIP  
PRIMARY EXAMINER